

### REMARKS

This responds to the Advisory Action mailed on June 6, 2008.

No claims are amended, cancelled, or added, relative to the Amendment and Response filed May 19, 2008; as a result, claims 132-134, 137-139, and 168-220 are pending in this application.

#### *Request for Reconsideration in view of the Advisory Action*

Applicant thanks Examiner Susannah Chung for the courtesy extended during a telephone discussion on June 19, 2008, during which an aspect of the Advisory Action was clarified. It was concluded that the serial code of the copending application cited against the instant application was incorrectly noted in the Advisory Action. Because the instant application (Serial No. 10/665,314) is senior to copending application 11/444,145, it is Applicant's understanding that the provisional double patenting rejection will be reconsidered and withdrawn, according to M.P.E.P. 804 I.B.1., first paragraph.

For the Examiner's convenience, the remarks filed with the Amendment and Response of May 19, 2008 regarding the provisional double patenting rejection, claim objection, and request for rejoinder are repeated below. Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

#### *Obviousness-Type Double Patenting Rejection*

Claims 132-134 and 136-142 were rejected under the judicially created doctrine of double patenting over claims 1-24, 68-71 and 91 of copending application Serial No. 11/444,145. Applicant respectfully traverses the rejection.

Applicant notes that the "series code" of copending application Serial No. 11/444,145 was incorrectly written as "10", as opposed to "11", on page 6 of the Office Action dated October 11, 2007. The correct serial number is found on page 7 of that Office Action but is incorrectly recited in the Office Action response of January 10, 2008 (page 33) and the Office Action dated March 19, 2008 (page 2). Because neither the present application nor copending application Serial No. 11/444,145 have been allowed, a terminal disclaimer is not required at this

time. Applicant further notes that because neither application has been allowed or has issued, it is believed that the rejection should be a provisional rejection. Accordingly, if a terminal disclaimer is required it can be requested by the Examiner before issuance of the latter of either the present application or the '145 application. Withdrawal of the rejection is respectfully requested.

### *Claim Objection*

Claim 136 was objected to because it depended on a subsequent claim. The Examiner suggested that claim 136, which depended upon claim 169, be cancelled and added at the end of the claims. The cancellation of claim 136 and the addition of claim 170 is believed to obviate the objection to claim 136.

### *Request for Rejoinder*

In the response filed July 24, 2006, Applicant requested rejoinder of the withdrawn claims upon a notice of allowable subject matter for the claims under examination. Applicant believes that claims 132-134, 137-139, and 168-189 are now in condition for allowance. Accordingly, the Examiner is respectfully requested to rejoin the subject matter of original claims 116-126 and 130-131 ("kit" claims), which now correspond to claims 190-220. The subject matter of original claims 116-126 and 130-131 that is directed to compounds (D-luciferin derivatives) has been amended in a manner corresponding to the amendments to the elected compound claims (see, e.g., compound claim 132 and kit claim 190, and compound claim 169 and kit claim 199).

**CONCLUSION**


Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3270 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 359-3270

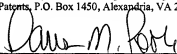
Date 6/19/2008

By   
Michael H. Haukaas  
Reg. No. 57,111

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19 day of June 2008.



Name



Signature